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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,487	10/27/2003	Steven D. Kaplan	RASE 8755US	4276

1688 7590 06/16/2005

POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERS COURT DRIVE SUITE 200
ST. LOUIS, MO 63131-3615

EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,487

Applicant(s)

KAPLAN, STEVEN D.

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>051905.120803</u> | 6) <input type="checkbox"/> Other: ____ |

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 11, 23, 34, 45 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11, 23, 34, 45 and 55 contain the trademark/trade name Kevlar. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe aromatic polyamide and, accordingly, the identification/description is indefinite.

- 3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Japan 109

- 4) **Claims 47, 48, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 109 (JP 4-159109).**

The claimed low friction material reads on the polyethylene sheet 60 of extra high molecular weight on the sidewall of the tire. See figure 1 and abstract.

Japan 833

- 5) **Claims 47, 48, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 833 (JP 4-71833).**

The claimed low friction material reads on the paint composition containing ultrahigh molecular weight polyethylene powder coated on the sidewall of the tire. See figure and abstract.

Japan 177

- 6) **Claims 1-4, 6, 8, 13-16, 18, 20, 25-27, 29, 31, 36-38, 40, 42, 47-48, 50 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 177 (JP 3-246177).**

Japan 177 discloses a pneumatic tire having a tread, shoulders, sidewalls, bead portions and a friction reducing member at each shoulder. In figure 11, the friction reducing members 56, 56 are Teflon (PTFE) sheets ("coatings"). In figure 13, the friction reducing members are rod shaped resin spikes ("molded material inserted to the tire"). In figure 14, the friction reducing members are rivet shaped resin spikes.

The claimed tire is anticipated by Japan 177's tire. The claimed low friction material reads on the friction reducing members. As can be seen from figures 11-14,

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the friction reducing members may be disposed "along an edge of the tread portion" such that the shoulders and the sidewalls comprise the friction reducing members. The description of "for preventing vehicle rollover or oversteer" relates to intended use and fails to require tire structure not disclosed by Japan 177.

7) Claims 5, 7, 17, 19, 28, 30, 39, 41, 49, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 177 in view of Japan 348 (JP 61-7348) or Japan 413 (JP 63-218413).

It would have been obvious to use the claimed material for Japan 177's friction reducing members since conventional low friction material includes ultrahigh molecular weight polyethylene incorporated in rubber as evidenced by Japan 348 or Japan 413.

8) Claims 5, 9, 17, 21, 28, 32, 39, 43, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 177 in view of Costa Pereira et al (US 6116313).

It would have been obvious to use the claimed material for Japan 177's friction reducing members since conventional low friction material includes rubber based on dimethyl siloxane (silicone material) / fatty acid amide in rubber blend (low friction material incorporated in rubber) as evidenced by Costa Pereira et al (col. 2 lines 53-64)

9) Claims 7, 10-12, 19, 22-24, 30, 33-35, 41, 44-46, , 51 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 177 in view of Muramatsu et al (US 5540489) and/or Bartkowiak (US 5069331).

It would have been obvious to use the claimed material for Japan 177's friction reducing members since (1) conventional low friction material includes nylon, ultrahigh molecular weight polyethylene and ceramic as evidenced by Muramatsu (US 5540489)

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and/or (2) conventional low friction material includes nylon, Kevlar (aromatic polyamide) and ceramic as evidenced by Bartkowiak (col. 4 lines 30-40).

Japan 403

10) **Claims 1-3, 6, 13-15, 18, 25-26, 29, 36-37, 40, 47-48, 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 403 (JP 2-197403).**

Japan 403 discloses a pneumatic tire having a tread, shoulders, sidewalls, bead portions and a low friction member 8 on the side of the tire (at the sidewall / shoulder) as shown in figure 1. During sudden turning, the low friction members contact the road to force the tire to slip. The claimed tire is anticipated by Japan 403's tire. The low friction material reads on the low friction members.

11) **Claims 1-4, 6, 8, 13-16, 18, 20, 25-27, 29, 31, 36-38, 40, 42, 47-48, 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 403 and optionally at least one of Japan 177 and Matsumoto (US 6102094).**

Japan 403, discussed above, is considered to anticipate claim 1. In any event: it would have been obvious to one of ordinary skill in the art to form Japan 403's tire such that the low friction member is provided at a shoulder and / or sidewall of the tire as claimed in view of (1) Japan 403's teaching to **provide a tire with low friction members** arranged *below the tread surface at each side of the tire* as shown in figure 1 so that upon sudden turning of a vehicle, the low friction member contacts the road surface and forces the tire to slip and optionally (2) (a) Japan 177's suggestion to arrange low friction members *at the shoulder and sidewall of the tire* as shown in figures 11-14 and/or (b) Matsumoto's suggestion to arrange different material *at the shoulder*

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and sidewall of a tire as shown in figures 9, 10, 11, 12a and 12b.

As to claims 8, 20, 31, 42 and 52, it would have been obvious to use a fluoropolymer as Japan 403's low friction members since conventional low friction material includes Teflon (PTFE) as evidenced by Japan 177.

12) Claims 5, 7, 17, 19, 28, 30, 39, 41, 49, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 403 and optionally at least one of Japan 177 and Matsumoto as applied above and further in view of Japan 348 (JP 61-7348) or Japan 413 (JP 63-218413).

It would have been obvious to use the claimed material for Japan 403's low friction members since conventional low friction material includes ultrahigh molecular weight polyethylene incorporated in rubber as evidenced by Japan 348 or Japan 413.

13) Claims 5, 9, 17, 21, 28, 32, 39, 43, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 403 and optionally at least one of Japan 177 and Matsumoto as applied above and further in view of Costa Pereira et al (US 6116313).

It would have been obvious to use the claimed material for Japan 403's low friction members since conventional low friction material includes rubber based on dimethyl siloxane (silicone material) / fatty acid amide in rubber blend (low friction material incorporated in rubber) as evidenced by Costa Pereira et al (col. 2 lines 53-64)

14) Claims 7, 10-12, 19, 22-24, 30, 33-35, 41, 44-46, 51 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 403 and optionally at least one of Japan 177 and Matsumoto as applied above and further in view of

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Muramatsu et al (US 5540489) and/or Bartkowiak (US 5069331).

It would have been obvious to use the claimed material for Japan 403's low friction members since (1) conventional low friction material includes nylon, ultrahigh molecular weight polyethylene and ceramic as evidenced by Muramatsu (US 5540489) and/or (2) conventional low friction material includes nylon, Kevlar (aromatic polyamide) and ceramic as evidenced by Bartkowiak (col. 4 lines 30-40).

Remarks

15) Gilbert (US 6170594) is of interest for disclosing applying fluid to tires to dissipate rollover including force by sliding laterally in preference to rolling over (i.e. teaches the solution of using friction reducing material to cause a tire to slip and thereby prevent rollover).

Corvasce et al 800 (US 6036800) and Corvasce et al 726 (US 6202726) are of interest for disclosing a tread base comprising high molecular weight polyethylene in rubber and a sidewall insert comprising high molecular weight polyethylene in rubber, respectively.

The remaining references are of interest.

16) No claim is allowed.

17) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

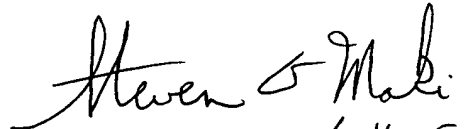
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
June 11, 2005


STEVEN D. MAKI 6-11-05
PRIMARY EXAMINER
~~GROUP 1300~~
AU 1733